

IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
11400 BURNET ROAD
AUSTIN, TEXAS 78758
FAX # 512

DATE:

8/15/05Number of Pages to Follow (including cover sheet) 7

RECEIVED
CENTRAL FAX CENTER

AUG 16 2005

SEND TO:

United States Patent Office

Examiner:

A. Chouhury

Group Art Unit:

2143

Tel No:

571-272-3909

Fax #:

571-273-8300

FROM:

J.B. KRAFT

Tel No:

512- 473-2303

THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED, AND MAY CONTAIN INFORMATION THAT IS PRIVILEGED, CONFIDENTIAL AND EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAW. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS ABOVE VIA THE U.S. POSTAL SERVICE. THANK YOU.

Docket No:

AUS92001004849

Serial No.

09/826,708

Atty:

J.B. KRAFT

Applicant:

☒ Transmittal Letter (2 copies)☐ Certificate of Facsimile☒ ~~Transmittal~~ Amendment☐ Notice of Appeal☐ Amendment AF☐ Appeal Brief (3 copies)☐ Ext. of Time☐ Reply Brief☐ IDS Statement☐ Change of Address☐ Other

Deposit Acct. No.

09-0447Fees: Amendment ☒Notice of Appeal ☐Appeal Brief ☐Other ☐

BEST AVAILABLE COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: R. Dutta

DOCKET NUMBER: AUS920000048US1

Date: 8/15/05

Serial No.: 09/826,708

Filed: April 5, 2001

For: System and Method for Customized E-Mail Services

COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, VA 22303-1450

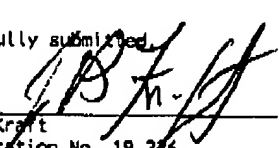
Sir:

Transmitted herewith is a Response in the above-identified Application.☒ No additional fee is required. No claims have been added.☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account 09-0447. A duplicate copy of this sheet is enclosed.☒ Any additional fees required under 37 CFR 81.16 for the presentation of extra claims.☒ Any patent application processing fees under 37 CFR 81.17.

Customer No. 32,329

Respectfully submitted,

By


J. B. Kraft
Registration No. 19,226
Intellectual Property Law Dept.
IBM Corporation
11400 Burnet Road - 4054
Austin, Texas 78758
(512) 473-2303

PATENT
09/826,708

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Group Art Unit: 2143
: Examiner: A. Choudhury
Rabindranath Dutta et al. : Intellectual Property
Serial No: 09/826,708 : Law Department - 4054
Filed: 04/05/2001 : International Business
Title: SYSTEM AND METHOD FOR : Machines Corporation
CUSTOMIZED E-MAIL SERVICES : 11400 Burnet Road
: Austin, Texas 78758
: Customer No. 32,329

Date: 8/15/05CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence including the present Response and accompanying Transmittal letter is being transmitted via facsimile to USPTO, Group Art Unit 2143 at telephone number 571-273-8200, and to the attention of Examiner A. Choudhury on 8/15/05.

Signature J.B. KRAFTDate 8/15/05

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AUS920010048US1

BEST AVAILABLE COPY

PATENT
09/826,708

RESPONSE

This is in response to the Official Action mailed May 16, 2005.

The new rejection of claims 1-26 under 35 U.S.C. 103(a) over the combination of Sklandman et al. (US6,400,810) in view of Lee et al. (US6,212,553) is respectfully traversed. As will be hereinafter established, neither reference suggests the present invention. Also, Examiner's proposed combination of elements from these two references in an attempt to show obviousness was not made in the light of any teaching in either reference but in light of Applicants' own teaching. Applicants submit that such combination of references is not valid.

The advance of the present invention involves the recognition that the sender of E-mail messages may be enabled to customize the sent messages by creating tags to indicate the importance of the message wherein the tags are varied between one recipient and another, i.e. the sender determines differences in importance of the E-mail message between the recipients based upon the needs of the recipients. Independent claims 1, 13, and 20, and their respective dependent claims 2-4, 13-16, and 21-23 define this advance.

In Sklandman, the flags indicative of the importance of received e-mail messages are determined solely by the recipients of the messages, and are set based upon only recipient input at the notification server of the recipient which advises the recipient that an E-mail message has been received. The Examiner admits this in the last sentence of the first paragraph on page 3 of the Official Action. It is clear from the column 3, lines 4-61, in Sklandman cited by the Examiner that the subscriber i.e. the recipient of the

BEST AVAILABLE COPY

PATENT
09/826,708

E-mail sets the attribute and corresponding priority flags which determine how future received E-mail will be handled in the recipient's notification server.

The Examiner relies on the teaching of Lee to make up for these deficiencies in Sklandman. The Examiner is not very specific on what Lee is supposed to contribute to the combination of references. The Examiner cites a six column section in Lee (col. 20, l. 41 through col. 26, l. 59 for the general teaching that priorities in E-mail may be set by either the sender or the recipient. Applicants have reviewed these sections in Lee, and at best they set forth the very general and known functions: that senders of E-mail may set priority flags for the E-mail, e.g. "Urgent" or "normal" which is applicable for the E-mail message irrespective of the recipient; or conversely the recipient may set up his personal priorities for all incoming E-mail messages without any sender input. In this extensive six column citation in Lee, Applicants could not find anything suggestive of sender input to a recipient of an E-mail message which creates a priority tag specific to that recipient which varies from the priority tag sent by the sender of the same E-mail message to another recipient.

Independent claim 5 is submitted to be patentable over Sklandman in view of Lee for all of the reasons set forth above for the Patentability of independent claim 1. In addition, claim 5 sets forth that the recipient's E-mail preferences are communicated to the sender prior to the sending of an E-mail message so that the sender may use these preferences in determining the priority tags. In arguing the obviousness of this claim, Examiner contends that Lee suggests that the recipients preferences for incoming E-mail set up in the notification server of Sklandman could be sent to the sender before the E-mail was

PATENT
09/826,708

sent so that the sender could then use such information in creating priority flags specific to the recipient. Applicants submit that the very general and broad range disclosure in the cited six columns of Lee fails to suggest any preliminary information going from a future recipient to a potential sender of E-mail.

The last argument is also applicable in establishing the unobviousness of claims 7-12, and 24-26. All of these claims contain the limitation that a preference concerning received E-mail of a potential E-mail recipient is communicated to a potential sender before any E-mail message is sent. There appears to be no suggestion in the cited six columns of Lee of preliminary information going from a future recipient to a potential sender of E-mail.

Since the Official Action of May 16, 2005 was a non-final rejection based on new art, Applicants have under separate cover requested a telephone interview in order to explore possible patentable subject matter herein.

In view of the foregoing, Applicants submit that claims 1-26 are now in condition for allowance and such allowance is respectfully requested.

Respectfully submitted,

J.B. Kraft 8/5/05
J. B. Kraft
Attorney for Applicants
Registration No. 19,226
(512) 473-2303

PLEASE MAIL ALL CORRESPONDENCE TO:

Jeffrey S. LaBaw
IFLaw Dept. - IMAD 4054
IBM Corporation
11400 Burnet Road
Austin, Texas 78758

BEST AVAILABLE COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DOCKET NUMBER: AUS92000048US1

Date: 8/15/05

In re application of: R. Dutta

Serial No.: 09/826,708

Filed: April 5, 2001

Port System and Method for Customized E-Mail Services

COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, VA 22303-1450

Sir:

Transmitted herewith is a Response in the above-identified Application.☒ No additional fee is required. No claims have been added.☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account 09-0447. A duplicate copy of this sheet is enclosed.☒ Any additional fees required under 37 CFR §1.16 for the presentation of extra claims.☒ Any patent application processing fees under 37 CFR §1.17.

Customer No. 32,329

Respectfully submitted,

By

J.B. Kraft

Registration No. 19,226

Intellectual Property Law Dept.

IBM Corporation

11400 Burnet Road - 4054

Austin, Texas 78758

(512) 473-2303

BEST AVAILABLE COPY